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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,904	08/11/2006	Wayne M. Moreau	FIS920030012US1	7740
33074 7590 10/22/2010 INTERNATIONAL BUSINESS MACHINES CORPORATION DEPT. 18G BLDG. 321-482 2070 ROUTE 52 HOPEWELL JUNCTION, NY 12533				
EXAMINER				
LEE, SIN J				
ART UNIT		PAPER NUMBER		
1722				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

EFIPLAW@US.IBM.COM

1. The declaration under 37 CFR 1.131 submitted by applicants was carefully considered but was found be unpersuasive in overcoming present 103(a) rejections over Yoneda et al'861 in view of Koguchi et al'244 for the following reason:

MPEP 715.03 states that proof of prior completion of a species different from the species of the reference or activity will be sufficient to overcome a reference indirectly under 37 CFR 1.131 if the species shown in the reference or activity would have been obvious in view of the species shown to have been made by the applicant. In re Clarke, 356 F.2d 987, 148 USPQ 665 (CCPA 1966); In re Plumb, 470 F.2d 1403, 176 USPQ 323 (CCPA 1973); In re Hostettler, 356 F.2d 562, 148 USPQ 514 (CCPA 1966). In the instant case, 1,2-dimethylimidazole (the specie disclosed in Yoneda) would not have been obvious in view of 4-dimethylaminopyridine (the specie shown in the Exhibit B). Alternatively, MPEP 715.03 also states that if the applicant cannot show possession of the species of the reference or activity in this manner, the applicant may be able to antedate the reference or activity indirectly by, for example, showing prior completion of one or more species which put him or her in possession of the claimed genus prior to the reference's or activity's date. The test is whether the species completed by applicant prior to the reference date or the activity's date provided an adequate basis for inferring that the invention has generic applicability. In re Plumb, 470 F.2d 1403, 176 USPQ 323 (CCPA 1973); In re Rainer, 390 F.2d 771, 156 USPQ 334 (CCPA 1968); In re Clarke, 356 F.2d 987, 148 USPQ 665 (CCPA 1966); In re Shokal, 242 F.2d 771, 113 USPQ 283 (CCPA 1957). In the instant case, it is the Examiner's position that the 4-

dimethylaminopyridine (the specie shown Exhibit B) would not put applicants in possession of the claimed genus (imidazoles) prior to the reference's or activity's date. Thus, it *does not* appear to the Examiner that applicants have met either test (i.e., 4-dimethylaminopyridine does not appear to make the 1,2-dimethylimidazole obvious nor provide support for the full genus). Therefore, present 103(a) rejection on claims 8, 10, 12 and 13 over Yoneda et al'861 in view of Koguchi et al'244 and present 103(a) rejection on claim 11 over Yoneda et al'861 in view of Koguchi et al'244 and further in view of Okumura et al'218 still stand.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sin J. Lee/

Primary Examiner, Art Unit 1795

October 19, 2010